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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/882,940	06/15/2001	Jerry B. Decime	10008055-1	9541

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HEWLETT-PACKARD COMPANY  
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EXAMINER

CAMPBELL, JOSHUA D

ART UNIT

PAPER NUMBER

2179

DATE MAILED: 05/25/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/882,940

Applicant(s)

DECIME ET AL.

Examiner

Joshua D Campbell

Art Unit

2179

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 07 April 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-6 and 8-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-6 and 8-20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

### **DETAILED ACTION**

1. This action is responsive to communications: Request for Continued Examination filed on 04/07/2005.
2. Claims 1-6 and 8-20 are pending in this case. Claims 1, 11, and 16 are independent claims.

#### **Swearing Back of Reference — Affidavit or Declaration Under 37 CFR 1.131**

1. The affidavit or declaration must state FACTS and produce such documentary evidence and exhibits in support thereof as are available to show conception and completion of invention in this country or in a NAFTA or WTO member country (MPEP §715.07(c)), at least the conception being at a date prior to the effective date of the reference. Where there has not been reduction to practice prior to the date of the reference, the applicant or patent owner must also show diligence in the completion of his or her invention from a time just prior to the date of the reference continuously up to the date of an actual reduction to practice or up to the date of filing his or her application (filing constitutes a constructive reduction to practice, 37 CFR 1.131). The showing of facts must be sufficient to show conception of the invention prior to May 23, 2001, (the effective date of the reference) coupled with due diligence from prior to May 23, 2001, to June 15, 2001, (the filing date of the application) (constructive reduction to practice).

##### **a. Conception**

Conception is the mental part of the inventive act, but it must be capable of proof, as by drawings, complete disclosure to another person, etc. In *Mergenthaler v. Scudder*,

1897 C.D. 724, 81 O.G. 1417 (D.C. Cir. 1897), it was established that conception is more than a mere vague idea of how to solve a problem; the means themselves and their interaction must be comprehended also.

The affidavit or declaration and exhibits must clearly explain which facts or data applicant is relying on to show completion of his or her invention prior to the particular date. Vague and general statements in broad terms about what the exhibits describe along with a general assertion that the exhibits describe a reduction to practice "amounts essentially to mere pleading, unsupported by proof or a showing of facts" and, thus, does not satisfy the requirements of 37 CFR 1.131(b). In re Borkowski, 505 F.2d 713, 184 USPQ 29 (CCPA 1974). Applicant must give a clear explanation of the exhibits pointing out exactly what facts are established and relied on by applicant. 505 F.2d at 718-19, 184 USPQ at 33. See also In re Harry, 333 F.2d 920, 142 USPQ 164 (CCPA 1964) (Affidavit "asserts that facts exist but does not tell what they are or when they occurred."). The statement in the applicants' declaration "Upon information and belief, the invention disclosure form that described the subject matter of the '940 application," is insufficient because it fails to provide a clear explanation of the exhibit, it is not sufficient to simply state that the disclosure shows the invention.

After thoroughly examining Exhibit A the examiner cannot make a determination on whether or not the entire claimed invention is disclosed. The Exhibit is not typed and the handwriting is difficult to read. Clear and concise statements of where the evidence of each claimed limitation occurs in the Exhibit would be necessary to make a determination regarding Conception.

**b. Diligence**

Where conception occurs prior to the date of the reference, but reduction to practice is afterward, it is not enough merely to allege that applicant or patent owner had been diligent. *Ex parte Hunter*, 1889 C.D. 218, 49 O.G. 733 (Comm'r Pat. 1889). Rather, applicant must show evidence of facts establishing diligence.

The critical period for diligence for a first conceiver but second reducer begins not at the time of conception of the first conceiver but just prior to the entry in the field (May 23, 2001) of the party who was first to reduce to practice and continues until the first conceiver reduces to practice (June 15, 2001). *Hull v. Davenport*, 90 F.2d 103, 105, 33 USPQ 506, 508 (CCPA 1937) ("lack of diligence from the time of conception to the time immediately preceding the conception date of the second conceiver is not regarded as of importance except as it may have a bearing upon his subsequent acts"). What serves as the entry date into the field of a first reducer is dependent upon what is being relied on by the first reducer, e.g., conception plus reasonable diligence to reduction to practice (*Fritsch v. Lin*, 21 USPQ2d 1731, 1734 (Bd. Pat. App. & Inter. 1991), *Emery v. Ronden*, 188 USPQ 264, 268 (Bd. Pat. Inter. 1974)); an actual reduction to practice or a constructive reduction to practice by the filing of either a U.S. application (*Rebstock v. Flouret*, 191 USPQ 342, 345 (Bd. Pat. Inter. 1975)) or reliance upon priority under 35 U.S.C. 119 of a foreign application (*Justus v. Appenzeller*, 177 USPQ 332, 339 (Bd. Pat. Inter. 1971) (chain of priorities under 35 U.S.C. 119 and 120, priority under 35 U.S.C. 119 denied for failure to supply certified copy of the foreign application during pendency of the application filed within the twelfth month)).

The evidence submitted, in the applicants' declaration, is insufficient to establish diligence from a date prior to the date of reduction to practice of the Google (Google Friends Newsletter, May 23, 2001) reference to either a constructive reduction to practice or an actual reduction to practice. The applicants' declaration and evidence fail to show diligence during the critical period (just prior to May 23, 2001 through June 15, 2001), while the applicants' declaration shows no evidence at all dealing with diligence. As stated above, it is not enough merely to allege that applicant or patent owner had been diligent, and because there is no evidence supporting diligence the declaration is insufficient.

For the above reasons the Affidavit/Declaration Under 37 CFR 1.131 is not proper in its current form and thus not sufficient to prove conception or diligence in order overcome the previous rejections.

***Claim Rejections - 35 USC § 103***

3. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
4. Claims 1-3, 5-8, 10-12, 14-17, and 19-20 remain rejected under 35 U.S.C. 103(a) as being unpatentable over Google (Google Friends Newsletter, May 23, 2001) in view of Nielsen (US Patent Number 5,875,443, issued on February 23, 1999).

**Regarding independent claim 1**, Google discloses a method in which an unfamiliar word is identified and an alternative spelling of that word is supplied as a word variant (Page 2, "Google Spell checker almost reads your mind", and Pages 5 and 6 of Google). Google discloses that both the unfamiliar word and the word variant are run through a search engine to show the frequency of use of both words and that the results are presented to the user (Page 2, "Google Spell checker almost reads your mind", and Pages 5 and 6 of Google). Google does not disclose a method in which the unfamiliar word is identified in a document during the execution of an automatic spell-checker. However, Nielsen discloses a method in which unfamiliar words are identified in a document during the execution of a spell checker (column 3, line 17-column 4, line 47 of Nielsen). It would have been obvious to one of ordinary skill in the art at the time the invention was made to have combined the method of Google with the method of Nielsen because it would have made it easier to correct large, lengthy volumes of text.

**Regarding dependent claims 2 and 3**, Google does not disclose a method in which a word is identified as unfamiliar by determining whether or not it is stored in a database and then providing suggestions based on similarly spelled words in the database. However, Nielsen discloses a method in which a word is identified as unfamiliar by determining whether or not it is stored in a database and then suggestions are provided based upon similarly spelled words in the database (column 3, line 16-column 4, line 47 of Nielsen). It would have been obvious to one of ordinary skill in the art at the time the invention was made to have combined the methods of Google with

the method of Nielsen because it would allowed for a working adaptable list to be kept to be used by more than one user.

**Regarding dependent claims 5 and 6**, Google discloses a method in which the using the search engine comprises transmitting the words to an Internet search engine via a network from a remote location (Page 2, "Google Spell checker almost reads your mind", and Pages 5 and 6 of Google).

**Regarding dependent claim and 8**, Google discloses a method in which an indication of the frequency of the words is expressed in terms of hits (Pages 5 and 6 of Google). Google can be used to search the open Internet or a database of categories (Pages 4 and 7-8 of Google).

**Regarding dependent claim 9**, Google does not disclose a method in which the frequency of results is shown as a percentage. However, Google discloses a method in which the amount of pages searched is displayed and the amount of pages that are hits is displayed (Pages 4-6 of Google). The percentage of pages that are hits is simply a function of these two values. It would have been obvious to one of ordinary skill in the art at the time the invention was made to have used the methods of Google and the method of showing frequencies by percentages because it was well known in the art at the time the invention was made that percentages were used, by definition, to show the proportion of a whole that meets certain criteria.

**Regarding dependent claim 10**, Google discloses that the user may select and continue searching by selecting either the original or moving to the word variant once a



decision is made based on the results (Page 2, "Google Spell checker almost reads your mind", and Pages 5 and 6 of Google).

**Regarding independent claims 11 and dependent claims 14 and 15**, the claims incorporate substantially similar subject matter as claims 1 and 10. Thus, the claims are rejected along the same rationale as claims 1 and 10.

**Regarding independent claims 16 and dependent claims 19 and 20**, the claims incorporate substantially similar subject matter as claims 1 and 10. Thus, the claims are rejected along the same rationale as claims 1 and 10.

**Regarding dependent claims 12 and 17**, the claims incorporate substantially similar subject matter as claim 2. Thus, the claims are rejected along the same rationale as claim 2.

5. Claims 4, 13, and 18 remain rejected under 35 U.S.C. 103(a) as being unpatentable over Google (Google Friends Newsletter, May 23, 2001) in view of Nielsen (US Patent Number 5,875,443, issued on February 23, 1999) as applied to claims 1, 11, and 16 above, and further in view of Lawrence (US Patent Number 6,393,444, filed on March 10, 1999).

**Regarding dependent claim 4**, neither Google nor Nielsen disclose a method in which the alternative spelling is generated by an algorithm to replace letters of an unfamiliar word with similarly sounding letters. However, Lawrence discloses a method in which the alternative spelling is generated by an algorithm to replace letters of an unfamiliar word with similarly sounding letters (phonetically) (column 1, line 33-column

2, line 31 of Lawrence). It would have been obvious to one of ordinary skill in the art at the time the invention was made to have combined the methods of Google and Nielsen with methods of Lawrence because it would have provided more accurate alternative spelling results.

**Regarding dependent claims 13 and 18**, the claims incorporate substantially similar subject matter as claim 4. Thus, the claims are rejected along the same rationale as claim 4.

### ***Response to Arguments***

6. Applicant's arguments filed 04/07/2005 have been fully considered but they are not persuasive.

Regarding the arguments on pages 7-11, regarding claims 1-6 and 8-20, the arguments are based solely on the use of the Declaration under C.F.R. 1.131 to show the inapplicability of the Google reference. As shown above, the Declaration was shown to be insufficient, thus the Google reference is still applicable, and the rejection of the claims stands as previously and currently presented.


### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Joshua D Campbell whose telephone number is (571) 272-4133. The examiner can normally be reached on M-F (8:00 AM - 4:30 PM).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Heather Herndon can be reached on (571) 272-4136. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

JDC  
May 19, 2005

  
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TECHNOLOGY CENTER